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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,739	12/24/2003	Nabil Hanna	037003-0307368	9111
909 7590 05/20/2008 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER				
DAVIS, MINH TAM B				
ART UNIT		PAPER NUMBER		
1642				
MAIL DATE		DELIVERY MODE		
05/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/743,739

Applicant(s)

HANNA ET AL.

Examiner

MINH-TAM DAVIS

Art Unit

1642

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/29/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47.51-63.65 and 68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47.51-63.65 and 68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant cancels claim 64.

Accordingly, claims 47, 51-63, 65, 68 are being examined.

Withdrawn Rejection

The 112, second paragraph has been withdrawn in view of cancellation of claim 64. The 103 rejection has been withdrawn in view of the amendment, but would be reinstated if said amendment were cancelled. It is noted that the reference by Ozbun et al, 1996, still is not received in the Office.

Obviousness-type Double Patenting

Claims 47, 51-63, 65, 68 of the instant application remain non-provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-2, 4-19 of US Application Serial No. 09/853581, now US patent No. 6,998,125, for reasons already of record in paper of 11/01/07.

The response asserts that a terminal disclaimer executed by the undersigned will be considered when one or more claims of the instant application are in condition for allowance.

The rejection remains, for reasons already of record in paper of 11/01/07. The issue of execution of a terminal disclaimer however will be delayed until the time of allowance, if the examined claims were allowable.

NEW REJECTION BASED ON THE AMENDMENT

Claim Rejections - 35 USC § 112, First Paragraph, Enablement

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 47, 51-63, 65, 68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

To comply with the enablement requirement of 35 U.S.C. § 112, first paragraph, the specification must enable one skilled in the art to make and use the claimed invention without undue experimentation. The claims are evaluated for enablement based on the Wands analysis. Many of the factors regarding undue experimentation have been summarized in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed.Circ.1988) as follows: (1) the nature of the invention, (2) the state of the prior art, (3) the predictability or lack thereof in the art, (4) the amount of direction or guidance present, (5) the presence or absence of working examples, (6) the quantity of experimentation necessary, (7) the relative skill of those in the art, and (8) the breadth of the claims.

The specification shows that in mice inoculated with cancerous HOPE2 cell line transfected with the papillomavirus protein HPV-E7, and treated with E7 and anti-TGF-beta antibody, anti-tumor activity is enhanced synergistically as compared to the additive effect of E7 and anti-TGF-beta antibody alone (Example 2 on pages 17-18, and figure 2A-B).

The specification however does not have any data or objective evidence that in cervical cancer, treated with E7 and anti-TGF-beta antibody, anti-tumor activity is enhanced synergistically as compared to the additive effect of E7 and anti-TGF-beta antibody alone.

One cannot predict that the HOP2 cell line transformed with E7 protein has the property of cervical cancer. The HOP2 cell line is a melanoma cell line and is not a cervical cancer cell line (Hariharan et al, 1998, Intl J Oncology, 12(6): 1229-1235, abstract only). Further, E7 is a viral oncoprotein, and is associated with various papillomavirus induced cancers, which cancers include for example head and neck carcinoma and not just cervical cancer (Moustafa et al, 2004, Oncogene, 23(30): 5252-5256). In addition, neoplastic transformation could be induced using E6/E7 protein in a normal oral epithelium (Moustafa et al, 2004, Oncogene, 23(30): 5252-5256). In view of the teaching in the art, one cannot predict whether the HOP2 cell line transformed with E7 protein has the property of melanoma or cervical cancer. Since different cancers have different properties, and do not predictably respond to the same drug in the same way, one cannot predict that in cervical cancer, treated with E7 and anti-TGF-beta antibody, anti-tumor activity is enhanced synergistically as compared to the additive effect of E7 and anti-TGF-beta antibody alone.

MPEP 2164.03 teaches that "the amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability of the art. In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The amount of guidance or direction refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more

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predictable the art is, the less information needs to explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as how to make and use the invention in order to be enabling.”

Given the above unpredictability, and in view of the complex nature of the invention, a lack of sufficient disclosure in the specification, and little is known in the art concerning the claimed invention, there would be an undue quantity of experimentation required for one of skill in the art to practice the claimed invention, that is commensurate in scope of the claims.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §

706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LARRY HELMS can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MINH-TAM DAVIS
May 16, 2008

/Larry R. Helms/
Supervisory Patent Examiner, Art Unit 1643